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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/156,334      | 09/18/1998  | RANJIT N. NOTANI     | 020431.0463         | 9944             |

7590 10/10/2002

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DALLAS, TX 752012980

EXAMINER

DIXON, THOMAS A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3629

DATE MAILED: 10/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/156,334

Applicant(s)

NOTANI ET AL.

Examiner

Thomas A. Dixon

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-12 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) 21-47 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19, 48 is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-12, 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's appeal brief's statement of issues presents some valid and invalid arguments regarding the claims which should be addressed, therefore, the finality of that action is withdrawn.

### ***Response to Arguments***

2. Applicant's amendments have been to the preambles of the independent claims and are not seen to materially change the claims. Therefore, the previous rejection is maintained.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., managing the workflow, which is recited in the preamble only) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 5-7, 10-12, 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Though the preamble states a computer implemented process the steps do not reveal any manipulation by any apparatus, therefore it is not seen to be in the technological arts.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the preamble states “operable to manage a distributed workflow” while the body of the claims to merely “interact” with workflows. Therefore, no weight will be given to the managing language.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Flores et al (6,073,109).

As per Claim 1.

Flores et al ('109) discloses:

storing a set of predetermined functions for a workflow to be performed at a plurality of distributed nodes, see column 13, line 44 – column 14, line 22 and column 16, lines 36-67;

automatically interacting with the workflow at each of the distributed nodes to perform the predefined functions, see column 13, lines 40-53.

As per Claim 3.

Art Unit: 3629

Flores et al ('109) further discloses the predefined functions are operable to transmit data associated with the operation of the workflow at each of the distributed nodes to a monitoring system, see Column 11, lines 48-67, column 10, lines 28-60, column 9, lines 21-30 and column 4, lines 30-59.

As per Claim 4.

Flores et al ('109) further discloses the predefined functions are operable to deploy the workflow to the distributed nodes, see Column 6, lines 9-33.

***Allowable Subject Matter***

5. Claims 15-19, 48 are allowable.

6. Claims 1-4<sup>2</sup> would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

7. Claims 5-7, 10-12, 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

As per Claims 5, 48.

The prior art of record, specifically Flores et al ('069 or '109) in view of Cloud et al ('127) fails to disclose or fairly teach receiving responses to the response of the second enterprise, the responses of the first and second enterprises ultimately resulting in a final collaboration based on the preliminary collaboration and optimized for the first and second enterprises.

As per Claim 15.

The prior art of record, specifically Flores et al ('069 or '109) in view of Cloud et al ('127) fails to disclose or fairly teach receiving a final collaboration approved by the first, second and third enterprises and

transmitting a predefined second part of the collaboration to a predefined third enterprise for operation at the third enterprise.

As per Claim 20.

The prior art of record, specifically Flores et al ('069 or '109) in view of Cloud et al ('127) fails to disclose or fairly teach receiving a second predefined set of data associated with operation of a second portion of the collaboration at a second node of a

second enterprise, the second set of data having been collected in response to an automatic query of the second node for the second set of data; and  
automatically transmitting the second set of data from the computer-implemented process to the monitoring system in response to the querying of the second node.

The claims that depend from the above allowable claims are allowable for the same reasons.

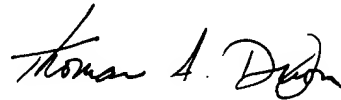
7. Claims 2, 18, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Thomas A. Dixon  
Examiner  
Art Unit 3629

October 9, 2002